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The time period for reply, if any, is set in the attached communication.

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

MAILED

Application Number: 09/801,298
Filing Date: March 07, 2001
Appellant(s): MAHONEY ET AL.

JUL 1 7 2007

GROUP 3600

Roland A. Fuller III
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed March 8th, 2007 appealing from the Office

action mailed October 19th, 2006.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6959235   ABDEL-MALEK et al.   10-2005

6892317   SAMPATH et al.   5-2005

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-18 are rejected under 35 U.S.C. 103 (a). This rejection is set forth in

prior Office Action. The rejection is set forth below as it appears in the previous Office

Action mailed on October 19th, 2006.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Abdel-Malek et al (6,959,235) in view of Sampath et al (6,892,317).

(A)   As per claim 1, Abdel-Malek discloses a computer-implemented vehicle repair

claim processing method having a computer system, comprising the steps of: receiving

with the computer system repair claim data related to repair of a vehicle (See Abdel-

Malek, Col.19, lines 1-18); having the computer system determine at least one response

to the input repair claim data based upon the received input repair claim data by using

expert rules stored in a knowledge based system of the computer system (See Abdel-

Malek, Col.21, lines 8-52), having the computer system make said expert rules being

accessible by a user in a high level computer expression format (See Abdel-Malek,

Col.5, lines 4-10).

Abdel-Malek does not explicitly disclose said repair claim expert rules including

repair claim-related premises and repair claim related actions, wherein the computer

system uses at least one of the repair claim-related premises to determine whether a

preselected repair claim-related action should be executed based on the received repair

claim data and generates a claim-related response based on said preselected repair

claim–related action.

However, these features are known in the art, as evidenced by Sampath. In

particular, Sampath suggests said repair claim expert rules including repair claim-

related premises and repair claim related actions, wherein the computer system uses at

least one of the repair claim-related premises to determine whether a preselected repair

claim-related action should be executed based on the received repair claim data and

generates a claim-related response based on said preselected repair claim–related

action (See Sampath, Col.8, lines 48-67 to Col.9, line 3).

It would have been obvious to one of ordinary skill in the art at the time of the

invention to have included the feature of action determined by a diagnostic server, and

the transmission of specific data types directly or indirectly to one or more of a service

provider and /or parts/consumables supplier, the appropriate assistance, repair, parts

and /or suppliers are provided to the electronic system(s) which is predicted to fail or

has failed (See Sampath , Col.3, lines 11-16).

(B)   As per claim 2, Abdel-Malek discloses the method wherein the repair claim data

includes dealer involved in the repair, vehicle identification number of the vehicle to be

repaired, parts involved in the repair, and labor operation data (See Abdel-Malek, Col.1,

lines 12-30).

(C)   As per claim 3, Abdel-Malek discloses the method further comprising the steps

of: accessing a database to retrieve information related to the vehicle to be repaired

(See Abdel-Malek, Col.8, lines 1-49).

(D)   As per claim 4, Abdel-Malek discloses the method further comprising the steps

of: having the computer system evaluate a repair claim by using a plurality of repair

claim –related expert rules to evaluate a repair claim (See Abdel-Malek, Col.5, lines 1-

18); having the computer determining that at least one of the rules requires additional

data related to the repair (See Abdel-Malek, Col.543-65); having the computer system

accessing a database to retrieve the additional data (See Abdel-Malek, Col.6, lines 52-

67).

(E)   As per claim 5, Abdel-Malek discloses the method wherein the repair claim data

includes dealer involved in the repair, vehicle identification number of the vehicle to be

repaired, parts involved in the repair, and labor operation data (See Abdel-Malek

Col.10, lines 7-53), said labor operation data being indicative of the labor involved in the

repair, said method further comprising the steps of: having the computer system use a

plurality of repair claim –related expert rules to evaluate a repair claim (See Abdel-

Malek, Col.10, lines 26-59); having the computer system determine via the repair claim-

related expert rules that an inconsistency exists based upon the labor operation data

(See Abdel-Malek, Col.12, lines 45-67).

(F)   As per claim 6, Abdel-Malek discloses the method wherein the repair claim data

includes warranty data related to the repair, said method further comprising the steps of:

having the computer system use the plurality of repair claim–related expert rules to

evaluate the warranty data related to the repair (See Abdel-Malek, Col.13, lines 33-44);

having the computer system provide a response to an user that is indicative of whether

the repair is covered by warranty based upon evaluation by the repair claim-related

expert rules (See Abdel-Malek, Col.10, lines 26-59).

(G)   As per claim 7, Abdel-Malek discloses the method further comprising the steps

of: having the computer system use a lower level representation of the repair claim-

related expert rules when the at least one of the repair claim-related premises uses the

received repair claim data to determine whether a preselected repair claim related

action should be executed (See Abdel-Malek, Col.10, lines 7-59); and having the

computer system display to an user the high level computer expression format of the

repair claim-related expert rules (See Abdel-Malek, Col.10, linnes 7-59).

(H)   As per claim 8, Sampath discloses the method wherein the high level computer

expression format of the repair claim-rule is an English phrase (See Sampath, Col.13,

lines 1-18), wherein the lower level representation of the repair claim –related rule is at

least one line of programming code (See Sampath, Col.13, lines 20-32).

The motivation for combining the respective teachings of Abdel-Malek and

Sampath are as discussed above in the rejection of claim 1, and incorporated herein.

(I)   As per claim 9, Sampath discloses the method wherein the programming code is

C++ programming code (See Sampath, Col.13, lines 20-32).

The motivation for combining the respective teachings of Abdel-Malek and

Sampath are as discussed above in the rejection of claim 1, and incorporated herein.

(J)   As per claim 10, Abdel-Malek discloses a computer-implemented vehicle repair

claim processing apparatus, comprising: a computer system having an input for

receiving repair claim data to repair of a vehicle (See Abdel-Malek, Col.19, lines 1-18);

said expert rules being accessible by an user in a high level computer expression

format (See Abdel-Malek, Col.5, lines 4-10).

Abdel-Malek does not explicitly disclose claim expert rules stored in a knowledge base of the computer system that the computer system uses to determine at least one response to the input repair claim data based upon the received input repair claim data,

said repair claim expert rules including repair claim- related premises and repair claim-related actions, wherein at least one of the repair claim-related premises uses the received repair claim data to determine whether a preselected repair claim-related action should be executed; said preselected repair claim- related action being used by the computer system to generate a repair claim-related response.

However, these features are known in the art, as evidenced by Sampath. In particular, Sampath discloses claim expert rules stored in a knowledge base of the computer system that the computer system uses to determine at least one response to the input repair claim data based upon the received input repair claim data (See Sampath, Col.8, lines 48-67 to Col.9, line 3),

said repair claim expert rules including repair claim- related premises and repair claim-related actions, wherein at least one of the repair claim-related premises uses the received repair claim data to determine whether a preselected repair claim-related action should be executed (See Sampath, Col.12, lines 23-67); said preselected repair claim- related action being used by the computer system to generate a repair claim-related response (See Sampath, Col.12, lines 23-67).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the feature of action determined by a diagnostic server, and the transmission of specific data types directly or indirectly to one or more of a service

provider and /or parts/consumables supplier, the appropriate assistance, repair, parts

and /or suppliers are provided to the electronic system(s) which is predicted to fail or

has failed (See Sampath, Col.3, lines 11-16).

(K)   Claims 11-18 recite the underlying process steps of the elements of claims 2-9,

respectively. As the various elements of claims 2-9 have been shown to be either

disclosed by or obvious in view of the collective teachings of Abdel-Malek and Sampath,

it is readily apparent that the method disclosed by the applied prior art performs the

recited underlying functions. As such, the limitations recited in claims 11-18 are rejected

for the same reasons given above for method claims 2-9, and incorporated herein.

(10) Response to Argument

In the Appeal Brief filed on 3/8/07, Appellant makes the following arguments:

(i) Abdel-Malek does not disclose said repair claim expert rules including repair-related premises and repair claim related actions, wherein the computer system uses at least one of the repair claim-related premises to determine whether a preselected repair claim-related action should be executed based on the received repair claim data and generates a claim-related response based on said preselected repair claim-related action.

(ii) Neither Abdel-Malek nor Sampath disclose a repair claim processing method or a repair claim processing apparatus.

(iii) Abdel-Malek fails to disclose the limitations of claims 1 and 10 that require that the computer system make the expert rules accessible by a user at all, let alone in a high level computer expression format.

(iv) The rejections of claims 1-18 under 35 U.S.C. 103 (a) are in error.

(B)   Examiner will address Appellant's arguments in sequence as they appear in the Brief.

In response to Appellant first argument, it is respectfully submitted that Appellant fails to ignore the definition of Syntax in programming language which controls rules as

to structure and content of statements. Various languages have been known in the

programming languages such as "Cobol, C++, Pascal, Unix, Java ETC. In this case,

Appellant fails to properly consider the clear and unmistakable teachings of the applied

references, and further fails to properly consider the breadth of the claim limitations

presently argued. With this in mind, it is the clear and unmistakable teaching of the

secondary reference of Sampath that the Examiner has relied upon See Col.6, lines 17-

65 particularly lines 35-46; Col.13, lines 19-32. Further, it appears that Appellant's

seeks to assign a specific meaning to the term "expert rule" which is not explicitly

defined via a positive and concrete definition within the present specification, nor further

refined in the bodies of the pending claims. As such, the Examiner respectfully

submitted that such terms were given their broadest reasonable interpretations during

examination, and since the applied reference clearly discloses the claimed limitations,

when given their broadest reasonable interpretations, it is respectfully submitted that the

Examiner's reliance on Sampath for such a feature is indeed proper. Therefore,

Appellant's claimed feature is not persuasive and the rejection is hereby sustained.

(C)   In response to Appellant second argument, it is respectfully submitted that

Appellant fails to ignore the clear and unmistakable teaching for such a feature See

Abdel- Malek Col.3, lines 1-14. Therefore, Appellant's argument is not persuasive and

the rejection is hereby sustained.

(D)   In response to Appellant third argument, it is respectfully submitted that Appellant

fails to ignore the clear and unmistakable teaching for such a feature. In addition,

Examiner respectfully submitted that He relied upon the teaching of Abdel-Malek whom

suggests "a repair methodology". The expert recommendations are supplemented by

repair information, such as schematics, maintenance manuals, and other technical

documentation stored at the MSDC and made available at the portable unit (See Abdel-

Malek, Col.2, lines 53-67). Futher, Abdel-Malek suggests that "warranty information can

be accessed and warranty claims submitted through the portable unit of the present

invention. The portable unit incorporates graphical user interfaces for ease of use and

comprehension. With the availability of all this information at track side, the repair

process can sometimes be moved from the repair shop to run-through or service track

sites, thus providing significant productivity gains and cost savings to the railroad. The

portable unit can also interface with and communicate with the locomotive on-board

monitoring systems for downloading or uploading fault and parametric operational data

collected during operation" which correspond to Appellant's claimed feature See Abdel-

Malek, Col.3, lines 1- 14). Furthermore, Examiner respectfully submitted that He has

been equated a rule based system, expert systems and other reasoning mechanisms to

be a form of "expert rule" (See Abdel-Malek in Col.6, lines 35-57) which correspond to

Appellant's claimed feature. Therefore, Appellant's argument is not persuasive and the

rejection is hereby sustained.

(E)   In response to Appellant fourth argument against the references of Abdel-Malek

and Sampath, Examiner respectfully submitted that obviousness is determined on the

basis of the evidence as a whole and the relative persuasiveness of the arguments. See

In re Oetiker, 977F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re*

Hedges, 783F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1992); *In re Piasecki* , 745

F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir.1984); and *In re Rinehart*, 531 F.2d

1048, 1052, 189 USPQ 143, 147 (CCPA 1976). Using this standard, the Examiner

respectfully submits that he has at least satisfied the burden of presenting a prima facie

case of obviuosness, since he has presented evidence of corresponding claim elements

in the prior art by expressly pointing to specific portions of each applied reference and

has expressly articualted the combinations and the motivations for combinations as

well as the scientific and logical reasoning of one skilled in the art at the time of the

invention that fairly suggest Appellant's claimed invention.

Each applied reference does not expressly suggest combination with the other

respective references; however, the Examiner has shown that motivation for combining

the references existed in the prior art. Within the present combinations, all of the

modifications proposed by the Examiner are taught by the references and that

knowledge generally available to one of ordinary skill in the art. Therefore, the

combination of references is proper and the rejection maintained.

In addition, the Examiner recognizes that references cannot be arbitrarily altered

or modified and that there must be some reason why one skilled in the art would be

motivated to make the proposed modifications. However, although the Examiner

agrees that the motivation or suggestion to make modifications must be articulated, it is respectfully contended that there is no requirement that the motivation to make modifications must be expressly articulated <u>within the references themselves</u>. References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures, *In re Bozek*, 163 USPQ 545 (CCPA 1969).

The Examiner is concerned that Appellant apparently ignores the mandate of the numerous court decisions supporting the position given above. The issue of obviousness is not determined by what the references expressly state but by what they would reasonably suggest to one of ordinary skill in the art, as supported by decisions in *In re DeLisle* 406 Fed 1326, 160 USPQ 806; *In re Kell, Terry and Davies* 208 USPQ 871; and *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ 2d 1596, 1598 (Fed. Cir. 1988) (citing *In re Lalu*, 747 F.2d 703, 705, 223 USPQ 1257, 1258 (Fed. Cir. 1988)). Further, it was determined in *In re Lamberti et al,* 192 USPQ 278 (CCPA) that:

(i)   obviousness does not require absolute predictability;

(ii)   non-preferred embodiments of prior art must also be considered; and

(iii)   the question is not <u>express</u> teaching of references, but what they would suggest.

According to *In re Jacoby*, 135 USPQ 317 (CCPA 1962), the skilled artisan is presumed to know something more about the art than only what is disclosed in the applied references. In *In re Bode*, 193 USPQ 12 (CCPA 1977), every reference relies to some extent on knowledge of persons skilled in the art to complement that which is disclosed therein.

According to *Ex parte Berins*, 168 USPQ 374 (Bd. Appeals), there is no statutory limitation as to the number of references that may be used to demonstrate obviousness not what references expressly state but what they would reasonably suggest to one of ordinary skill in the art. In *In re Conrad*, 169 USPQ 170 (CCPA), obviousness is not based on express suggestion, but what references taken collectively would suggest.

Nonetheless, it is respectfully submitted that an explanation based on logic and sound scientific reasoning of one ordinarily skilled in the art at the time of the invention that support a holding of obviousness has been adequately provided by the motivations and reasons indicated by the Examiner in the previous Office Action, *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter., 4/22/93).

In addition, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). The skilled artisan would not consider the prior art embodiments in a vacuum, but would have had the motivation to combine the advantageous features of the prior art in the manner purported by the Examiner for the reasons and motivations given in the prior Office Action. Thus, the teachings of Abdel-Malek and Sampath when considered with the knowledge that is generally available to one of ordinary skill in the art make obvious the limitations that Appellant disputes.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the

Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejection should be sustained.

Respectfully submitted,

Vanel Frenel

Vanel Frenel

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